

REMARKS

The Examiner has rejected claims 1-2 and 4-12. Claims 1 and 4-12 stand rejected under 35 U.S.C. § 112, paragraph 1, as lacking enablement. Claims 1 and 4-12 stand rejected under 35 U.S.C. § 112, paragraph 2, as being indefinite. Claims 1-2 and 4-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichols et al. in U.S. Patent No. 6,194,423, in view of Tabor et al. in *Society of Neuroscience Abstracts*, No. 809-3, November 4-9, 2000 (XP-002231341).

In response, Applicants cancel claim 1 without prejudice and reserve the right to prosecute the invention as defined by canceled claim 1 in a continuation application filed under 35 U.S.C. § 120. In addition, Applicants amend claim 2, rewriting claim 2 in independent form, and amend claims 4-12 to correct the dependency of those claims following the canceling of claim 1. In addition, Applicants add new claims 13-15, depending from claim 2, and drawn to the embodiment where the agonist dose is reduced “at least twice every 24 hours to obtain a second lower tissue concentration of agonist.” Support for new claims 13-15 is found throughout the specification as filed, and in particular in FIG. 4 and the Examples. Accordingly, Applicants traverse the Examiner’s rejection of claims 2 and 4-12 as amended, and consider the same to be in condition for allowance. Applicants also consider new claims 13-15 to be in condition for allowance.

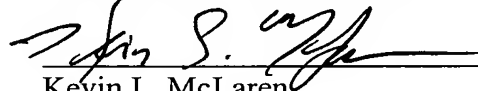
The Examiner has rejected claims 1 and 4-12 as lacking enablement. The Examiner states that “while being enabling for the method of treating Parkinson’s disease comprising the steps set forth in claim 1 comprising administering ‘dinapsoline, dinoxyline, dihydrexidine’, does not reasonably provide enablement for the term ‘D₁ agonist’.” Applicants have canceled claim 1, rewritten claim 2 in independent form, reciting all of the limitations of canceled claim 1, and amended claims 4-12 to ultimately depend from claim 2. Claim 2 requires that the “full D₁ agonist” is selected from the group consisting of dinapsoline, dinoxyline, dihydrexidine, and analogs and derivatives thereof. As stated, the Examiner has indicated that the claimed method is enabled for dinapsoline, dinoxyline, and dihydrexidine. Therefore, Applicants believe that claim 2 fully complies with Section 112, paragraph 1. Similarly, as claims 4-12 all ultimately depend from claim 2, Applicants believe they also fully comply with Section 112, paragraph 1.

The Examiner has also rejected claims 1 and 4-12 for being indefinite, stating, "The term 'full D₁ agonist' is indefinite." The Examiner also states, "The remaining claims 4-12 are indefinite to the extent that they depend from claim 1." Claim 1 has been canceled, and claim 2 requires that the full D₁ agonist is selected from the recited Markush group. Further, claims 4-12 as amended depend ultimately from claim 2. Therefore, Applicants believe that claims 4-12 comply with the requirements of Section 112, paragraph 2, as the term "full D₁ agonist" is specifically set forth in the claims as amended.

The Examiner has also rejected claims 1-2 and 4-12 as being unpatentable over Nichols et al. in view of Tabor et al. Applicants believe that Nichols et al. is useable as a reference only under 35 U.S.C. § 102(e). Therefore, pursuant to 35 U.S.C. § 103(c), Applicants respectfully inform the Examiner that Nichols et al. and the present invention were co-owned and/or subject to an obligation of assignment to both Purdue Research Foundation and University of North Carolina at Chapel Hill. The Examiner is kindly referred to the face of Nichols et al. showing the assignment to the above-referenced assignees, and to the assignment also showing the above-referenced assignees that was recorded in the instant application on Reel/Frame 012674/0146 and Reel/Frame 012674/0156, both on February 28, 2002. Accordingly, Applicants respectfully suggest that Nichols et al. is not useable as a reference pursuant to 35 U.S.C. § 103(c), and that the combination of Nichols et al. and Tabor et al. is improper. Hence, Applicants respectfully request that the Examiner reconsider the rejection of claims 2 and 4-12 as being unpatentable over these references leading to its withdrawal.

Applicants believe that the invention as defined by claims 2 and 4-15 fully complies with the requirements of the Patent Law, and in particular with Sections 112 and 103(a) forming the basis of the Examiner's standing rejections, and that claims 2 and 4-15 are in condition for allowance. Thus, Applicants respectfully request that the Examiner withdraw all of the outstanding rejections, and pass the instant application to issuance.

Respectfully submitted,
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